

REMARKS

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 2-18 are now present in this application. Claims 2, 6, 10 and 18 are independent.

By this Amendment, claim 1 is canceled, claims 2, 3, 6, 8-11 and 13-15 are amended, and claims 16-18 are added. No new matter is involved.

Reconsideration of this application, as amended, is respectfully requested.

Priority Under 35 U.S.C. § 119

Applicant thanks the Examiner for acknowledging Applicant's claim for foreign priority under 35 U.S.C. § 119 and receipt of the certified priority document.

Drawings

Applicant acknowledges receipt of the indication on the Form PTOL-326 that the formal drawings have been approved by the Draftsperson.

Claim Objections

The Examiner has objected to claim 10 because it contains two sentences. In order to overcome this objection, claim 10 is amended to change "request. From" to read --request,

from--, to overcome the typographical error which caused the claim to be in the form of two sentences. Also "audio/vido" is changed to read --audio/video--. Neither of these changes narrows the scope of the claims in any way.

Reconsideration and withdrawal of this objection are respectfully requested.

### Claim Amendments

Applicant has also amended claim 3 in order to correct a minor typographical error.

### Rejections under 35 U.S.C. § 103

Claims 1-4, 8 and 11-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 7,086,077 to Giammaressi in view of U.S. Patent Application Publication 2003/0154480 to Goldthwaite et al. ("Goldthwaite") and further in view of U.S. Patent Application Publication 2006/0015574 to Seed et al. ("Seed"). This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action and is not being repeated here.

Because the rejection is based on 35 U.S.C. § 103, what is in issue in such a rejection is "the invention as a whole," not just a few features of the claimed invention. Under 35 U.S.C. § 103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said

subject matter pertains." The determination under Section 103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. *See In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. *See Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. § 103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *Uniroyal Inc. v. F-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), *cert. denied*, 488 U.S. 825 (1988); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the

Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." *See In re Dembiczak*, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, it is well settled that the Office must provide objective evidence of the basis used in a prior art rejection. A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. *See In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Furthermore, during patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the Applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the Applicant to come forward to rebut such a case.

Initially, Applicant notes that this rejection is moot with respect to claim 1, which is canceled.

With respect to claim 2, Applicant respectfully submits that none of the applied references discloses or suggests the combination of features recited in claim 2, including in which the server judges whether A/V streams can be outputted in response to the request from the renderer; and a step in which the server provides the A/V streams to the renderer sequentially or simultaneously if the A/V stream can be outputted, or outputting a server unavailability message to the renderer if the server judges that the A/V streams cannot be outputted, wherein, in the step of judging whether A/V streams can be outputted, the server compares transmission time of entire A/V streams and A/V stream transmission time according to a defined reproduction capability of the server required for reproducing A/V streams, and then judges whether the A/V streams can be outputted.

Giammaressi is limited to determining bitrates for different quality levels of its data stream but contains no disclosure of comparing the transmission time of entire A/V streams with the determined bitrates for different quality levels of its data stream, as claimed. The Office Action states that this feature is disclosed by Giammaressi's disclosure of steps 210 and 214. Applicant respectfully disagrees with this assertion, because nowhere does Giammaressi disclose determining the transmission time of entire A/V streams, let alone comparing the transmission time of entire A/V streams with anything.

Goldthwaite, the secondary reference, is applied to teach a home network. However, Goldthwaite only discloses a home network as one example of a network that is usable with its invention, where Goldthwaite's invention concerns correlating a network user's collected data in

a historical format, which has nothing to do with the primary reference, which determines if requested information can be provided to a network subscriber. In other words, Goldthwaite has nothing to do with determining whether requested information can be provided to a network subscriber and, for at least this reason, one of ordinary skill in the art would have no proper incentive to look to Goldthwaite to modify Giammaressi's system to use it in a home network.

As pointed out by the Court of Appeals for the Federal Circuit, one "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1780, 1783 (Fed. Cir. 1988). Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability, which is the essence of improper hindsight.

Seed, the tertiary reference, is applied to disclose outputting an unavailable message if a server judges that A/V streams cannot be outputted. However, Seed fails to remedy the aforementioned shortcoming in Giammaressi.

Further, with respect to claims 4, 11 and 12, the Office Action includes a reference to U.S. Patent 5,671,377 to Bleidt. Applicant requests that the Examiner clarify exactly what the basis for the rejection of claims 4, 11 and 12 is, i.e., is it the three references mentioned in the summary of the rejection on page 2 of the Office Action, or does it also include the Bleidt reference, which is not even listed on a Form PTO-892, nor mentioned on page 2, but included in the discussion of the rejection of claim 4 on page 3 of the Office Action. Applicant also disagrees with the assertion that Bleidt is incorporated in its entirety in Giammaressi. At best,

Bleidt is one patent that was apparently cited during the prosecution of Giammaressi and is pointed to on the cover sheet of Giammaressi and, if the Examiner wants to rely on the Bleidt reference in this rejection, it is incumbent on the Examiner to state in the summary of the rejection that it is being relied upon and list it on a Form PTO-892, neither of which has been done.

Turning to Bleidt, Applicant notes that the cited portion of Bleidt in this rejection is included in Bleidt's discussion of disadvantages of disk drives in general, and of the fact that the lengthiest delay associated with using disk drives is introduced by the drive's recalibration. Unfortunately, the Office Action fails to explain what this has to do with Giammaressi's invention, or the claimed invention, and Applicant respectfully submits that it has nothing to do with the claimed invention.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the subject matter recited in currently pending claim 2 or claims 3, 4, 8 and 11-15, which depend from claim 2.

Reconsideration and withdrawal of this rejection of claims 1-4, 8 and 11-15 are respectfully requested.

Claims 6 and 7 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent 7,086,077 to Giammaressi in view of U.S. Patent Application Publication 2003/0154480 to Goldthwaite et al. ("Goldthwaite") and further in view of U.S. Patent Application Publication 2006/0015574 to Seed et al. ("Seed") and further in view of U.S. Patent 6,917,569 to Lam et al. ("Lam"). This rejection is respectfully traversed.

Initially, Applicant agrees with the admission in the Office Action that the Giammaressi-Goldthwaite-Seed reference combination applied in the rejection of claim 1 does not disclose wherein, in the step of judging whether A/V streams can be outputted, the server compares the overall transfer rate of the A/V streams being reproduced and a predetermined A/V stream transfer rate on the basis of the distance between a position where the A/V stream requested by the renderer has been recorded and a position where the A/V stream being reproduced has been recorded, as claimed.

In an attempt to remedy this deficiency, the Office Action turns to Lam, which is directed to managing a disk array storage device by using dynamic reallocation of data on a disk array storage device based on actual usage (col. 3, lines 15-17) and has no disclosure whatsoever of judging whether AV streams can be output to a renderer. Unfortunately, the Office Action never explains why one of ordinary skill in the art would be motivated to modify the base reference combination, which never discusses managing a disk array storage device, by turning to a disk array storage device managing system, in general, or by determining hard drive seek times to judge whether A/V streams can be outputted to a renderer. The alleged motivation to make the proposed modification of the base reference combination is “for the benefit of providing dynamic disk allocation based on actual usage.” Unfortunately, the Office Action fails to demonstrate that a user of the base reference combination’s server has a disk array that has a need for dynamic disk allocation or would be motivated to determine whether AV streams can be output to a renderer. In this regard, Lam has no disclosure of being used to determine whether AV streams can be output to a renderer.



Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the subject matter recited in currently pending claims 6 and 7.

Reconsideration and withdrawal of this rejection of claims 6 and 7 are respectfully requested.

Claims 5 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 7,086,077 to Giammaressi in view of U.S. Patent Application Publication 2003/0154480 to Goldthwaite et al. ("Goldthwaite") and further in view of U.S. Patent Application Publication 2006/0015574 to Seed et al. ("Seed") and further in view of U.S. Patent 6,189,071 to Bachmat. This rejection is respectfully traversed.

Initially, Applicant notes that the Giammaressi-Goldthwaite-Seed reference combination does not render obvious the subject matter of claim 2, from which claims 5 and 9 depend, for the reasons discussed above. Moreover, Bachmat is not applied in this rejection to remedy the aforementioned shortcomings of the Giammaressi-Goldthwaite-Seed reference combination with respect to claim 2. So, even if one of ordinary skill in the art were properly motivated to modify the Giammaressi-Goldthwaite-Seed reference combination based on Bachmat, as suggested, the so-modified version of the base reference combination would not render the claimed invention obvious.

Furthermore, Bachmat is directed to managing resources in a disk array storage device and has nothing whatsoever to do with judging whether A/V streams can be outputted to a user, especially a user that has not been shown to have a disk array storage device.

Unfortunately, the Office Action never explains why one of ordinary skill in the art would

be motivated to modify the base reference combination, which never discusses managing a disk array storage device, by turning to a disk array storage device managing system, in general, or by determining hard drive seek times to judge whether A/V streams can be outputted to a renderer. The alleged motivation to make the proposed modification of the base reference combination is “for the benefit of providing dynamic disk allocation based on actual usage.” Unfortunately, the Office Action fails to demonstrate that a user of the base reference combination’s server has a disk array that has a need for dynamic disk allocation or would be motivated to determine whether AV streams can be output to a renderer. In this regard, Lam has no disclosure of being used to determine whether AV streams can be output to a renderer.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the subject matter recited in currently pending claims 5 and 9.

Reconsideration and withdrawal of this rejection of claims 5 and 9 are respectfully requested.

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 7,086,077 to Giammaressi in view of U.S. Patent Application Publication 2003/0154480 to Goldthwaite et al. (“Goldthwaite”) and further in view of U.S. Patent Application Publication 2006/0015574 to Seed et al. (“Seed”) and further in view of U.S. patent 5,822,530 to Brown. This rejection is respectfully traversed.

Initially, Applicant notes that the Giammaressi-Goldthwaite-Seed reference combination does not render obvious the subject matter of claim 2, from which claim 10 depends, for the reasons discussed above. Moreover, Brown is not applied in this rejection to remedy the afore-

noted shortcomings of the Giammaressi-Goldthwaite-Seed reference combination with respect to claim 2. So, even if one of ordinary skill in the art were properly motivated to modify the Giammaressi-Goldthwaite-Seed reference combination based on Brown, as suggested, the so-modified version of the base reference combination would not render the claimed invention obvious.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the subject matter recited in currently pending claim 10.

Reconsideration and withdrawal of this rejection of claim 10 is respectfully requested.

### Claims 16-18

Dependent claims 16 and 17, and independent claim 18, are added. These claims are clearly supported in the Application as originally filed. With respect to claims 16 and 17, see, for example, page 6, line 14 through page 7, line 17. Claim 18 is supported, for example, throughout the originally filed specification, including page 6, lines 8-10 and, for example, originally filed claim 2, which is part of Applicant's original disclosure.

Claims 16 and 17 patentably define over the applied art because they depend from claim 2, which patentably defines over the applied art, for the reasons discussed above, and because of the features contained in each claim, which are not disclosed or suggested by the applied art. Claim 18 also patentably defines over the applied art for the reasons presented above with respect to claim 2.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46, 472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

Applicants respectfully petition under the provisions of 37 C.F.R. § 1.136(a) and § 1.17 for a one-month extension of time in which to respond to the Examiner's Office Action. The Extension of Time Fee in the amount of **\$120.00** is attached hereto.

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Art Unit 2623


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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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